



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/849,975

05/08/2001

Hajime Kimura

12732-044001

1362

26171 7590 02/28/2003

FISH & RICHARDSON P.C.  
1425 K STREET, N.W.  
11TH FLOOR  
WASHINGTON, DC 20005-3500

EXAMINER

LUU, THANH X

ART UNIT

PAPER NUMBER

2878

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/849,975

Applicant(s)

KIMURA, HAJIME

Examiner

Thanh X Luu

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 7-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 25-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 4-6, in Paper No. 6 is acknowledged. Claims 1-3 are generic.
2. Claims 1-32 are currently pending. Claims 7-24 are not examined since the claims are drawn to a non-elected invention.

### ***Drawings***

3. Figures 2-7 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2, 3, 5 and 6 provide for the use of the close contact type sensor, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 2, 3, 5 and 6 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3 and 26, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Kitamura et al. (U.S. Patent 5,149,955).

Regarding claims 1-3 and 26, Kitamura et al. disclose (see Figures 4 and 5) a close contact type sensor arranged with a plurality of unit pixels (2) each comprising a sensor circuit portion (5o) and a plurality of irradiation window portions (5c). Kitamura et al. further disclose (see column 1, lines 19-20) the sensor in a scanner or a portable information terminal (small sized facsimile terminal or bar code reader). Kitamura et al. also disclose (see column 4, lines 43-45) the sensor circuit portion (5o) comprises a photo diode.

9. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujieda et al. (U.S. Patent 5,877,492).

Regarding claims 1-6, Fujieda et al. disclose (see Figure 6) a close contact type sensor arranged with a plurality of unit pixels (groups of 4) each comprising a sensor circuit portion (4) and a plurality of irradiation window portions (5). Fujieda et al. further disclose (see Figure 6) an optical fiber plate (at 9) between the sensor circuit portion and a reading object (10); wherein an area of any of the plurality of irradiation window portions (5) is larger than an area of half of a section of a single piece of an optical fiber (9) in the optical fiber plate. Fujieda et al. further disclose (see column 1, lines 10-12) the sensor in a scanner or a portable information terminal (facsimile or hand scanner).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al. in view of Applicant's Admitted Prior Art (Figure 5), hereinafter, AAPA.

Regarding claims 27 and 28, Kitamura et al. further disclose (see column 4, lines 34-37) additional circuitry for driving and reading out the sensor. Kitamura et al. do not specifically disclose the circuitry as being an amplifying transistor or a resetting transistor. AAPA teach (see Figure 5) close contact sensors having support circuitry comprising amplifying and resetting transistors. Thus, AAPA recognize that amplifying and resetting transistors are common in such sensors. It would have been obvious to a

person of ordinary skill in the art at the time the invention was made to include amplifying and resetting transistors in the apparatus of Kitamura et al. in view of AAPA to improve detection through amplifying signals and clearing unwanted signals.

12. Claims 27, 28, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujieda et al. in view of Applicant's Admitted Prior Art (Figure 5), hereinafter, AAPA.

Regarding claims 27, 28, 31 and 32, Fujieda et al. disclose the claimed invention as set forth above. Fujieda et al. do not specifically disclose an amplifying transistor or a resetting transistor. AAPA teach (see Figure 5) close contact sensors having support circuitry comprising amplifying and resetting transistors. Thus, AAPA recognize that amplifying and resetting transistors are common in such sensors. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include amplifying and resetting transistors in the apparatus of Fujieda et al. in view of AAPA to improve detection through amplifying signals and clearing unwanted signals.

13. Claims 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujieda et al. in view of Kitamura et al.

Regarding claims 26 and 30, Fujieda et al. disclose the claimed invention as set forth above, wherein the sensor comprises a photoelectric conversion element. Fujieda et al. do not specifically disclose the sensor comprises a photo diode. Kitamura et al. teach provide a photo diode as the photoelectric conversion element in a close contact sensor. Thus, Kitamura et al. recognize that photo diodes are easily formed into close contact sensors. It would have been obvious to a person of ordinary skill in the art at

the time the invention was made to provide a photo diode in the apparatus of Fujieda et al. in view of Kitamura et al. to more easily manufacture a contact sensor.

14. Claims 25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Kitamura et al. or Fujieda et al. in view of Ratnakar et al. (U.S. Patent 6,421,468).

Regarding claims 25 and 29, Kitamura et al. and Fujieda et al. disclose the claimed invention as set forth above. Kitamura et al. and Fujieda et al. do not specifically disclose the sensor incorporated into the group of consisting of a digital still or x-ray camera as claimed. Ratnakar et al. teach (see column 4, line 60 - column 5, line 10) an input device such as a camera or an x-ray camera having a close contact sensor (CIS). Thus, Ratnakar et al. recognize that such devices use a close contact sensor as detectors. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the sensor of Kitamura et al. or Fujieda et al. in view of Ratnakar et al. in digital cameras or x-ray cameras to improve detection in such devices.

### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh X. Luu whose telephone number is (703) 305-0539. The examiner can normally be reached on Monday-Friday from 6:30 AM - 4:00 PM.

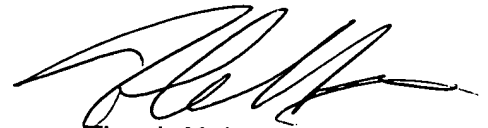
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta, can be reached on (703) 308-4852. The fax phone number for

Art Unit: 2878

the organization where the application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

txl  
February 10, 2003



Thanh X. Luu  
Patent Examiner